

Reply under 37 CFR 1.116 –Expedited Procedure
Art Unit 2853
Amendment for Application 10/715,937
Attorney Docket CFA00047US
Amendment Date: 4/17/06

REMARKS/ARGUMENTS

Upon entry of the present Amendment, Claims 1-4, and 10-13 will have been amended. By the present Amendment and Remarks, Applicant respectfully submits that that the rejections have been overcome, and respectfully requests reconsideration of the February 23, 2006 Office Action and allowance of the present application at the Examiner's earliest convenience.

Pending Claims

Claims 1-13 are pending in the application. Of these claims, Claims 1, 10, 11, 12, and 13 are independent claims and the remaining claims are dependent claims.

Summary of Rejections

Claims 1, 2 & 4-13 were rejected under 35 U.S.C. 102(b) as being anticipated in view of Silverbrook et al. (US PGPUB 2002/0080396).

Claim 3 was rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook et al (US PGPUB 2002/0080396) in view of Tan et al. (US 6,613,403).

Traversal of Rejection under 35 U.S.C. 102(b)

Applicant respectfully traverses the rejection of Claims 1, 2, & 4-13 under 35 U.S.C. 102(b) as being anticipated in view of Silverbrook et al. (US PGPUB 2002/0080396) [hereinafter “Silverbrook”].

Turning to the specific claim language of the present application, amended

independent Claim 1 is directed to a recording apparatus for forming an image on a recording medium comprising recording means for performing recording by applying a recording material onto the recording medium, the recording means recording at least one of a positional information image representing positional information corresponding to the position, where the positional information image is recorded and the image, and a control means for controlling the recording such that the recording means records the positional information image with a recording material capable of being detected by a predetermined detector, and the image with another recording material incapable of being detected by the detector, wherein the positional information image can arbitrarily be recorded on the recording medium.

The present invention of independent Claim 1 describes recording, on a recording medium, positional information image data, where the positional information image data represents positional information corresponding to the position where the positional image data is recorded. In addition, the present invention of independent Claim 1 also describes that the positional information image can be arbitrarily recorded on the recording medium.

Applicant respectfully submits that Silverbrook fails to disclose at least the above-noted features of the present invention.

Silverbrook is seen to describe a system for producing interface surfaces (“netpages”) which allow users to interact with networked information and to obtain interactive printed matter. More specifically, a “netpage” consists of a printed page (or other surface region) invisibly tagged with references (i.e., tags) to an online description

of the page. The tags may be printed on or into the surface of the page, may be in or on a sub-layer of the page or may be otherwise incorporated into the page. The online page description is maintained persistently by a netpage page server. The page description describes the visible layout and content of the page, including text, graphics and images. It also describes the input elements on the page, including buttons, hyperlinks, and input fields. A netpage allows markings made with a netpage pen on its surface to be simultaneously captured and processed by the netpage system (paragraph 0148).

Tags are printed in infrared-absorptive ink on any substrate which is infrared-reflective, such as ordinary paper (paragraph 0151). A tag is sensed by an area image sensor in the netpage pen, decoded and the data encoded by the tag is transmitted to the netpage system, preferably via the nearest netpage printer. The pen recognizes the tag and extracts the page ID and position on every interaction with the page. (paragraph 0152).

According to Silverbrook, in the preferred form of the invention, each tag identifies the region in which it appears, and the location of that tag within the region. A tag may also contain flags which relate to the region as a whole or to the tag. One or more flag bits may, for example, signal a tag sensing device to provide feedback indicative of a function associated with the immediate area of the tag, without the sensing device having to refer to a description of the region. (paragraph 0155).

Decoding a tag results in a region ID, a tag ID, and a tag-relative pen transform. Before the tag ID and the tag-relative pen location can be translated into an absolute location within the tagged region, the location of the tag within the region must be known. This is given by a tag map, where each tag ID in a tagged region is mapped to a corresponding function. A tag map reflects the scheme used to tile the surface region with

tags. The tag map for a region must be retrievable via the region ID. Thus, given a region

ID, a tag ID, and a pen transform, the tag map can be retrieved, the tag ID can be translated into an absolute tag location within the region, and the tag-relative pen location can be added to the tag location to yield an absolute pen location within the region (paragraphs 0193-0195).

A location-indicating tag contains a tag ID which, when translated through the tag map associated with the tagged region, yields a unique tag location with the region. The tag-relative position of the pen is added to this tag location to yield the location of the pen within the region. This in turn is used to determine the location of the pen relative to a user interface element in the page description associated with the region. The user interface element is identified, as well as a location relative to the user interface element. Location-identifying tags therefore trivially support the capture of an absolute pen path in the zone of a particular user interface element. (0198)

According to Silverbrook, in the preferred form of the invention, the tag map is associated with each page instance to allow tags on the page to be translated into locations on the page. (0209).

As the above referenced sections of Silverbrook illustrate, Silverbrook discloses the structure to detect a tag, printed on a recording medium with invisible ink, by a sensor on a pen. The position on the surface of the recording medium can be determined by reading the tag using the pen. The disclosed tag comprises at least 90 bits of region ID (paragraph 0158), which itself shows the position on the recording medium. In other words, encoded information showing the position on the recording medium is already included in the tag. In order to make use of the tag to yield an absolute position of the pen

within a region, a tag map mapping each tag ID in a tagged region to a corresponding

location is required.

Nothing in Silverbrook is seen to describe recording a positional information image, wherein the positional information can be arbitrarily recorded on a recording medium. As indicated above, each of the tags of Silverbrook contain tag ID information, which, when translated through a tag map associated with a tagged region, yields the position of the tag within the region. Since the tags of Silverbrook need to be translated, via the tag map, into locations on the recording medium, arbitrarily recording the tags would not allow for the invention of Silverbrook to work.

In the present invention, the recorded positional information image represents positional information corresponding to the position where the positional information image is recorded. As such, unlike the invention in Silverbrook, the present invention does not require a translation map. Thus, again, unlike the invention in Silverbrook, the present invention can arbitrarily record positional information image on a recording medium.

Nothing in Silverbrook is seen to indicate that an individual tag or combination of tags forms or form a positional information image. In other words, there is nothing in Silverbrook to suggest that the tags form an image representing positional information on the recording medium when the tags are recorded on the recording medium.

Because Silverbrook lacks at least the above-noted features of the present invention, Applicant submits that Silverbrook fails to disclose each and every feature recited in Claim 1, and that the Office Action fails to include adequate evidentiary basis to support a rejection of anticipation under 35 U.S.C. 102(b). Therefore, Applicant

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submits that the rejection of at least independent Claim 1 is improper and respectfully

requests that the rejection be withdrawn.

Furthermore, Applicant submits that Claims 2, and 4-9 are allowable at least for the reason that these claims depend from allowable base Claim 1 and recite additional features that further define the present invention.

In addition, amended independent Claims 10, 11, 12, and 13 were rejected essentially for the same reasons as independent Claim 1. Thus, independent Claims 10, 11, 12, and 13 are believed allowable for the same reasons as set forth in the discussion above.

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Traversal of Rejection under 35 U.S.C. 103(a)

Applicant respectfully traverses the rejection of Claim3 under 35 U.S.C. 103(a) as being unpatentable over Silverbrook in view of Tan et al. (US 6,613,403) [hereinafter "Tan"].

As discussed above, independent Claim 1 is directed to a recording apparatus for forming an image on a recording medium comprising recording means for performing recording by applying a recording material onto the recording medium, the recording means recording at least one of a positional information image representing positional information corresponding to the position where the positional information image is recorded and the image, and a control means for controlling the recording such that the recording means records the positional information image with a recording material capable of being detected by a predetermined detector, and the image with another recording material incapable of being detected by the detector, wherein the positional information image can arbitrarily be recorded on the recording medium.

Applicant respectfully submits that Silverbrook fails to disclose at least the above-described features of the present invention.

As is noted above, Silverbrook fails to disclose or even suggest these particular features of Claim 1. It is further noted that the aforementioned features are not taught or suggested in Ten either. Therefore, since neither Silverbrook nor Ten discloses or suggests these aforementioned features of the present invention, no proper combination of these documents can render unpatentable the asserted combination of features recited in at least independent Claim 1.

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Furthermore, Applicant submits that Claim 3 is allowable at least for the reason

that it depends from allowable base Claim 1 and recites additional features that further define the present invention.

Accordingly, Applicant respectfully requests the Examiner reconsider and withdraw the rejection of Claim 3 under 35 U.S.C. 103(a) as being unpatentable over Silverbrook in view of Tan, and indicate that this claim is allowable over the art of record.

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CONCLUSION

Applicant respectfully submits that each and every pending claim of the present invention meets the requirements for patentability, and respectfully requests the Examiner to indicate the allowance of such claims as the Examiner's earliest convenience.

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipate or render obvious the Applicant's invention as recited in Claims 1-13. The applied references have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein is respectfully requested and now believed to be appropriate.

Applicants' undersigned attorney may be reached at (949) 932-3329. All correspondences should be directed to the below-listed address.

Respectfully submitted,

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